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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 2721

SYLVESTER CAPAROTTA, d/b/a Kings Brush Company and as Kings Brush & Mop Company,

Petitioner,

v.

AMERICAN TECHNICAL MACHINERY CORPORATION,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No.

SYLVESTER CAPAROTTA, d/b/a Kings Brush Company and as Kings Brush & Mop Company,

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AMERICAN TECHNICAL MACHINERY CORPORATION,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

Petitioner, Sylvester Caparotta, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Second Circuit entered in this case on December 30, 1964.

Opinions Below

The opinion of the District Court (App., *infra*, pp. 9a-20a) is reported at 229 F. Supp. 479. The opinion of the Court of Appeals (App., *infra*, pp. 2a-6a) is reported at 339 F. 2d 557.

Jurisdiction

The judgment of the Court of Appeals was entered on December 30, 1964 (App., *infra*, p. 1a) and a timely petition for rehearing was denied on March 22, 1965 (App., *infra*, p. 7a). The jurisdiction of this Court is invoked under 28 U.S.C. §1254 (1).

Questions Presented

I. Where a patent is held to be valid over the prior art only insofar as the claims thereof are limited to the precise structure shown and described in the patent, and the accused device is found not to employ that structure, is infringement nevertheless established merely because such claims read literally on the accused device.

II. May a Court of Appeals, in reversing a lower court's finding of non-infringement of the claims of a patent, accord to such claims a scope broader than that accorded to the same claims by the lower court in finding them valid over the prior art.

Statute Involved

Title 35 of the United States Code

§271 (a). Infringement of patent

(a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

Statement of the Case

This suit was brought under 28 U.S.C. §1338 and §1400 against petitioner Sylvester Caparotta for infringement of United States Patent No. 2,742,327 issued on April 17, 1956 to Theodore Marks and assigned to respondent American Technical Machinery Corp.

The alleged Marks "invention" is a machine for making twisted wire brushes, the brush bristles being held between and by the twisted wires. The Marks brush-making machine is adapted to feed spaced sets of pre-cut bristles from a hopper between and across the lower of a pair of wires fed from spools, the wires holding the bristles in a more or less firm position at a right angle to the wires.

A specific mechanism is provided by Marks to hold the wires parallel and adjacent to thereby hold the bristles in position while the wires are being drawn out, the mechanism comprising a so-called holding fork lowered vertically to its ultimate position pressing one wire against the other and the jaws of a vise moved horizontally to hold the wires laterally in position.

The wires are drawn to a predetermined length, the bristles being fed between them during this period; when the predetermined length of wire (or brush) is reached, the wires are twisted throughout their length by a rotatable chuck, by which the ends of the wires are held. After the twisting operation, the wire is cut to form a completed brush. According to the disclosure of the Marks patent, all of the above operations are to be performed in a *sequential* manner.

In the accused Briglia machine, bristles from a hopper are deposited between two wires fed over pulleys from friction retarded spools, and passed between stationary

wire guides. Instead of drawing the wires to their predetermined length and then twisting the wires, a rotating chuck *simultaneously* pulls and twists the wires to form the twisted wire brush product.

Thus, in the accused machine there is not the extended parallel wire relationship of Marks nor the sequential operation thereof.

Finding that all of the elements of the patented Marks machine were old in the prior art except for the specific mechanism described in the Marks Patent for holding the wires in a parallel adjacent relationship, the District Court held the claims of the patent in suit valid only if limited to the precise device disclosed in the specification and claims; as so limited, he found that the accused Briglia machine did not infringe the claims. More specifically, the district court found that the accused machine omitted the very elements of the Marks machine which rendered the claims of the patent in suit valid over the prior art.

The District Court also found that the accused device operated in a substantially different manner from the Marks device, in that the patent in suit *requires* the pulling and twisting operations to be performed sequentially, whereas the accused machine performs these operations simultaneously.

The Court of Appeals, while accepting the District Court's limited finding of validity, reversed that court's finding of non-infringement and held the accused device to be an infringement of the claims in suit. The Court of Appeals said that the lower court had applied an improper legal test of infringement, and stated (App., *infra,* p. 5a) that the proper test of infringement was "whether the claims involved read directly on the accused machine, for 'the claims measure the invention.' *Con-*

tinental Paper Bag Co. v. *Eastern Paper Bag Co.*, 210 U. S. 405, 419; * * * see *Smith* v. *Snow*, 294 U. S. 1, 11 * * *."

Although the test of infringement set out in the opinion of the Court of Appeals is applicable where it has been found that the claims of the patent literally describe a meritorious invention, we submit that such a test is inapplicable in the fact situation of the present case. Here, the Court of Appeals accepted the findings of the District Court that the claims in issue are valid over the prior art only when the claim language was so construed as to be limited to the precise structure disclosed in the patent in suit.* In such a case, the proper test of infringement is that applied by the District Court and enunciated by this Court in *Westinghouse* v. *Boyden Power Brake Company*, 170 U. S. 537 (1898) and more recently in *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 339 U. S. 605 (1950) that even should the claims in suit read literally on an accused device, if such a device is so changed in principle from the patented invention as to constitute an entirely new device, then infringement is not made out. To infringe, one must use not only the patented, but the patentable invention.

In this case, the test of infringement of the Court of Appeals is clearly in conflict with the decisions of this Court in the *Westinghouse* and *Graver Tank* cases, *supra*.

Reasons for Granting the Writ

I.

In its decision, the District Court carefully considered the prior art and determined that

> "The means, *disclosed in the specifications*, for supporting the upper and lower wires substantially

* Literally taken, the claims read on the prior art just as readily as on the accused machine.

> parallel and adjacent to each other appear novel and nowhere disclosed by the prior art. Claims 6, 13, 16 and 17 *read too broadly in this regard* and they will be read in the light of the disclosure (citing cases). * * * The means *disclosed* is not found in the teaching of any of the prior art patents nor were the means obvious to one skilled in the art of brush-machine making. *To this extent,* the Court finds novelty in claims 6, 13, 16 and 17" (App. *infra* p. 16a). (Emphasis always ours unless otherwise indicated.)

Thus the District Court specifically held that four of the five claims in issue read too broadly unless limited to the specific means disclosed in the specifications.*

The District Court, having found that the literal language of the claims in suit had to be limited by the disclosure of the patent in order to find the claims valid over the prior art, then determined that petitioner's accused Briglia machine was not an infringement thereof since it did not utilize the specific mechanisms of the Marks patent, i.e. the patentable invention of that patent. In so doing, the District Court properly accorded the claims in suit a scope commensurate with the narrow invention defined thereby, applying *sub silentio,* the test of infringement laid down in *Westinghouse.*

In reversing, the Court of Appeals *accepted* the District Court's findings as to the issue of validity of the claims in suit, but completely ignored these same findings by according the claims a scope unwarranted by the narrow invention defined thereby. By misapplying the test of infringe-

* Claim 2, which is broader than claims 6, 13, 16 and 17 in that it does not recite means for supporting the wires *in parallel and adjacent relationship,* would also be too broad under the trial court's reasoning, unless it, too, was limited to the specific mechanisms and specific sequence of operation disclosed in the Marks specifications.

ment laid down by this Court in *Continental* v. *Eastern* and *Smith* v. *Snow, supra,* the Court of Appeals failed to take cognizance of the very different fact situations present in those two cases as compared to the fact situation present in this case. In both of the former cases, this Court found that the invention of the particular patent in suit was a meritorious one entitled to broad protection. Thus, in the *Continental* case, this Court accepted the findings of the two lower courts that the invention "was one of high rank" (210 U. S. 414) and "was a broad one" (210 U. S. 416). Similarly in the *Smith* case, this Court held that the inventor was entitled "to broad claims and to a liberal construction of those which he has made" (294 U. S. 14).

Whereas in *Continental* and *Smith,* the inventions were found to be significant contributions to science and industry, thus entitling them to broad protection, in this case the Marks invention was found by the District Court (*a finding concurred in by the Court of Appeals*) to be a narrow one at best and entitled to protection only in the precise form disclosed. In such a case, this Court has consistently applied a different test of infringement than that applied by the Court of Appeals here and has found non-infringement even though the claims in suit read literally on the accused device.

In *Westinghouse* v. *Boyden Air Brake Company,* 170 U. S. 537 (1898) this Court, in holding that the accused Boyden brake mechanism was not an infringement of the claims of the Westinghouse patent in suit, stated at page 568:

> "But even if it be conceded that the Boyden device corresponds with the letter of the Westinghouse claims, that does not settle conclusively the

> question of infringement. * * * The patentee may bring the defendant within the letter of his claims, but if the latter has so far changed the principle of the device that the claims of the patent, literally construed, have ceased to represent his actual invention, he is as little subject to be adjudged an infringer as one who has violated the letter of a statute has to be convicted, when he has done nothing in conflict with its spirit and intent."

In *Graver Mfg. Co.* v. *Linde Co.*, 339 U. S. 605 (1950), this Court discussed the general principles applicable to infringement of a valid patent. As stated by this Court, resort is first made to the language of the claims in issue and if accused matter falls clearly within such language, then infringement is made out. However, in cases where an accused device does not appropriate the patented invention although it comes within the literal language of the claims, the doctrine of equivalents will be applied to narrow the claims to the patentable invention only.

> "The wholesome realism of this doctrine [of equivalents] is not always applied in favor of a patentee but is sometimes used against him. Thus, where a device is so far changed in principle from a patented article that it performs the same or a similar function in a substantially different way, but nevertheless falls within the literal words of the claim, the doctrine of equivalents may be used to restrict the claim and defeat the patentee's action for infringement. *Westinghouse* v. *Boyden Power Brake Co.*, 170 U. S. 537, 568." (At pages 608-609.)

II.

The Court of Appeals was not critical of the District Court's finding of validity nor the basis thereof. In thus accepting the limited scope accorded the claims of the patent in suit by the District Court to find them valid—

more limited in fact than literal response to the claim language—the Court of Appeals was bound to accord such claims the same scope with respect to the issue of infringement.

It has been a well-established rule that a Court may not apply the claims of the patent in suit to the prior art in one way, so as to validate the claims, and then apply the same claims to the accused structure in another way, so as to find infringement. As stated in *Leeds & Northrup Co.* v. *Doble Engineering Co.*, 159 F. 2d 644, 648 (1 Cir. 1947):

> "In other words, although it is conceded that the claim must be construed one way to decide the question of validity, it is suggested that we construe it another way to decide the question of infringement. It seems to us obvious that the claims must be construed the same way on both issues."

To the same effect, see *Hazeltine Corp.* v. *Emerson Television-Radio, Inc.*, 129 F. 2d 580, 582 (2 Cir. 1942).

As the Court stated in *Penmac Corp.* v. *Esterbrook Steel Pen Mfg. Co.*, 108 F. 2d 695, 697 (2 Cir. 1940):

> "Plaintiff finds itself in the dilemma—not unusual for patentees—of having to treat its claims narrowly to avoid the defense of prior art and broadly to sustain the claim of infringement. For the purposes of this action we may content ourselves with assuming the validity of plaintiff's patents to reach a conclusion that defendant does not infringe them."

Conclusion

In according these claims a scope broader than that to which they were entitled, the Court of Appeals went directly contrary to the decisions of this Court in *Westinghouse* v. *Boyden* and *Graver* v. *Linde, supra.* For this reason the decision of the Court of Appeals should be reversed and the judgment of the District Court affirmed.

In the alternative, the Court of Appeals should be ordered to remand this case to the District Court for consideration by it of the validity of the claims in suit in light of the broadened scope accorded these claims by the Court of Appeals.

For the foregoing reasons this Petition for Writ of Certiorari should be granted.

Respectfully submitted,

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Of Counsel:

FRANCIS T. CARR,
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Dated June 18, 1965

Judgment of the Court of Appeals

UNITED STATES COURT OF APPEALS

FOR THE

SECOND CIRCUIT

At a Stated Term of the United States Court of Appeals, in and for the Second Circuit, held at the United States Courthouse in the City of New York, on the thirtieth day of December one thousand nine hundred and sixty-four.

Present—Hon. THOMAS W. SWAN,
Hon. STERRY R. WATERMAN,
Hon. LEONARD P. MOORE, Circuit Judges.

AMERICAN TECHNICAL MACHINE CORP.
(substituted for American Brush Machinery Company, Inc.),
Plaintiff-Appellant,

v.

SYLVESTER CAPAROTTA, doing business as Kings Brush Co., and as Kings Brush & Mop Co.,
Defendant-Appellant.

Appeal from the United States District Court for the Eastern District of New York.

This cause came on to be heard on the transcript of record from the United States District Court for the Eastern District of New York, and was argued by counsel.

ON CONSIDERATION WHEREOF, it is now hereby ordered, adjudged, and decreed that the judgment of said District Court be and it hereby is affirmed in part; reversed in part and that the action be and it hereby is remanded to the said District Court for further proceedings in accordance with the opinion of this court with costs to the plaintiff-appellant.

A. DANIEL FUSARO
Clerk

Opinion of the Court of Appeals

UNITED STATES COURT OF APPEALS

SECOND CIRCUIT

AMERICAN TECHNICAL MACHINE CORP.,
Plaintiff-Appellant-Appellee,

v.

Sylvester CAPAROTTA, d/b/a Kings Brush Co. and as Kings Brush & Mop Co.,
Defendant-Appellee-Appellant.

No. 47, Docket 28918
Argued Nov. 9, 1964.
Decided Dec. 30, 1964.

Before SWAN, WATERMAN and MOORE, Circuit Judges.

SWAN, Circuit Judge:

This is an appeal in a patent infringement suit. The patent is No. 2,742,327 which was applied for by Theodore Marks on April 20, 1951 and was issued to him April 17, 1956. We shall refer to it as the Marks patent, although by mesne assignments it is now owned by American Technical Machinery Corporation. The claims relied upon are 2, 16 and 17. They are printed in the margin.[1] Judge Mishler[2]

1. 2. In a fully automatic machine for forming a brush having spaced sets of fibers held between a pair of twisted wires, means for supporting a continuous under wire free at one end, means for supporting a continuous upper wire free at one end, means for feeding onto the under wire and between it and the upper wire fibers spaced from each other, means for drawing the under wire and the upper wire with the spaced fibers therebetween to a selected length, means for twisting

held the claims valid but not infringed. The plaintiff has appealed from the holding of non-infringement. The defendant counter-claimed for a declaration of invalidity of the patent, and has appealed from the dismissal of his counterclaim.

Plaintiff and defendant are competitors in making and selling brushes, and plaintiff also manufactures brush-making machinery.

The Marks Patent is a combination patent for a fully automatic machine for making brushes of the type commonly used in the household and in women's hair curlers. Judge Mishler's opinion clearly describes the Marks' machine as follows:

> "• • • the machine is designed to produce wire-twisted brushes of varying lengths not exceeding

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the wires to lock the fibers therebetween, and means for cutting the twisted wires to form the brush whereby the twisted wires are open at each end of the brush.

16. In a fully automatic machine for forming a brush, means for supporting and upper and a lower wire with leading portions substantially parallel and adjacent to each other, each wire being continuous with its leading portion having an exposed end, means for drawing the wires through the machine with said ends in the lead, means for feeding bristles onto the lower wire between it and the upper wire, means for twisting the wires to lock the bristles therebetween, and means for cutting the twisted wires to form the brush.

17. In a fully automatic machine for forming a brush, means for supporting an upper and a lower wire with leading portions substantially parallel and adjacent to each other, each wire being continuous with its leading portions having an exposed end, a reciprocable and rotable chuck for gripping said ends of the wires, means for moving the chuck to pull the wires gripped thereby a predetermined distance, means for feeding bristles onto the lower wire between it and the upper wire as said wires are being pulled by the chuck, means for gripping the wires remote from the exposed ends, and means for rotating the chuck to twist the wires and lock the bristles therebetween.

2. Whose opinion appears in 229 F.Supp. 479.

APPENDIX

approximately 3". An upper and lower wire are continuously fed into the machine from two spools, the upper and lower wires engage precut fibers or bristles fed from a hopper; the two wires holding the fibers or bristles in a more or less firm position, are then drawn into a predetermined length; the wires holding the bristles are then twisted by a rotating chuck; the twisted-wire brush is then cut. The brush is then complete and ready for packaging, except that in some varieties handles are added."

The court found that the Marks machine was an advance over the prior art; that it produced brushes faster than any previous brush-making machine, did not require the degree of skill in its operation that machines then known demanded, substantially reduced the cost of making twisted-wire brushes, was commercially successful, and the need for a low-priced brush was heightened by the widespread use of twisted brushes in hair curlers. Such considerations are consistent with the standard of patentability in this circuit. See *Reiner* v. *I. Leon Co.*, 2 Cir., 285 F. 2d 501, 504, cert. den. 366 U. S. 929, 81 S. Ct. 1649, 6 L. Ed. 2d 388; *Lyon* v. *Bausch & Lomb Optical Co.*, 2 Cir., 224 F. 2d 530, 535-537, cert. den. 350 U. S. 911, 76 S. Ct. 193, 100 L. Ed. 799; The Standard of Patentability—Judicial Interpretation of Section 103 of the Patent Act, 63 Columbia L. Rev. 306, 313—16.

These findings of fact are not clearly erroneous, and we must accept them. We also accept the finding that "The means disclosed is not found in the teaching of any of the patents nor were the means obvious to one skilled in the art of brush-machine making." Accordingly, we agree with Judge Mishler's decision as to the validity of the patent.

We do not agree with his holding of no infringement. The proper test of infringement is whether the claims involved read directly on the accused machine, for "the claims measure the invention." *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U. S. 405, 419, 28 S. Ct. 748, 52 L. Ed. 1122; see *Smith* v. *Snow*, 294 U. S. 1, 11, 55 S. Ct. 279, 79 L. Ed. 721; 3 Walker Patents §450, at 1681 (Diller ed.). In the case at bar the accused machine was the Briglia.[3] Judge Mishler compared plaintiff's machine with defendant's or, which is really the same thing, compared plaintiff's claims with defendant's machine but limited the claims to a range of equivalency substantially defined by plaintiff's "best mode." Both tests are erroneous; the former because it begins with plaintiff's machine and not plaintiff's claims; the latter because it too narrowly construes the protected range of equivalency.

It is true that narrow patents in a crowded field are not accorded as broad a range of equivalence as are pioneer patents, 3 Walker, Patents §475. But here both defendant and his expert testified that all of Marks' claims in suit could be read on the Briglia machine.

Nor could Briglia's simultaneous pulling and twisting the wires be conclusive evidence of non-infringement. Marks' claims did not limit these operations to separate steps, and there was testimony that the Marks machine could also so operate. The simultaneous operation was regarded as equivalent by defendant's expert, and the twisting operation was not only known to the prior art but was thought by the trial court to be "of no consequence * * *."

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3. Defendant, who was then using a Marks machine, employed Briglia to invent a machine to supplant Marks. In May 1960 Briglia filed a patent application, and a patent was issued to him in 1963. Defendant owns the Briglia patent.

Defendant is not saved by the difference in feeding wheels. Not only was defendant's mechanism thought equivalent to plaintiff's, but also both had been taught by the prior art. Besides, the mechanism was not the gist of Marks' novel combination as defined by the court.[4]

The court placed no weight on any "presumption of non-infringement" attaching to Briglia's patent. Defendant would treat that patent as establishing "more than a presumption" that the accused machine does not infringe. But the statutory presumption of validity of a patent is limited only to the existence of a patentable improvement. Cantrell *v.* Wallick, 117 U. S. 689, 694, 6 S.Ct. 970, 29 L. Ed. 1017. It need not be controlling once sufficient evidence of infringement of the basic patent has been introduced, as was done in the case at bar.

While we must accept findings of fact which are not clearly erroneous, we are not so limited as to erroneous views of the proper legal tests of infringement. See Up Right, Inc. *v.* Safeway Products, Inc., 5 Cir., 315 F.2d 23; Hansen *v.* Colliver, 9 Cir., 282 F.2d 66. Here the finding of non-infringement was based on an unduly narrow definition of the patent's protection.

The decision as to validity of the patent and dismissal of the counterclaim is affirmed. The decision of non-infringement is reversed and the cause remanded for further proceedings consistent with this opinion.

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4. His opinion (229 F.Supp. 482) says:

> "The vital question is, whether the means for feeding pre-cut fibers, more or less evenly spaced between an upper and lower wire substantially parallel and adjacent with each other, was either anticipated or obvious to one skilled in the art."

Denial of Petition for Rehearing

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

AMERICAN TECHNICAL MACHINE CORPORATION,
Plaintiff-Appellant-Appellee,

against

SYLVESTER CAPAROTTA, d/b/a Kings Brush Company,
and as Kings Brush & Mop Company,
Defendant-Appellee-Appellant.

Before: Swan, Waterman and Moore, U.S.C. JJ.

PETITION FOR REHEARING

Petition denied.

TWS

SRW

LPM

U.S.C. JJ.

March 22, 1965

Judgment of the District Court

IN THE

UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF NEW YORK

AMERICAN TECHNICAL MACHINERY CORP., (Substituted for American Brush Machinery Company, Inc.),

Plaintiff,

v.

SYLVESTER CAPAROTTA, doing business as Kings Brush Co. and as Kings Brush & Mop Co.,

Defendant.

This action came on for trial before the Court, Honorable Jacob Mishler, District Judge, presiding, and the issues having been duly tried and a decision having been duly rendered, and the Court having made Findings of Fact and Conclusions of Law dated and filed March 31, 1964

It is Ordered and Adjudged:

1. That claims 2, 6, 13, 16 and 17 of Patent No. 2,742,327 are valid;

2. That defendant's machine does not infringe claims 2, 6, 13, 16 and 17 of Patent No. 2,742,327;

3. That the complaint and the counterclaim are dismissed;

4. That each party bears its own costs.

Dated: April 14, 1964.

/s/ JACOB MISHLER
Hon. Jacob Mishler, U. S. D. J.

Opinion of the District Court

AMERICAN TECHNICAL MACHINERY CORP., (Substituted for American Brush Machinery Company, Inc.),
Plaintiff,

v.

SYLVESTER CAPAROTTA, doing business as Kings Brush Co. and as Kings Brush & Mop Co.,
Defendant.

No. 60-C-984.

United States District Court
E. D. New York,
March 31, 1964.

MISHLER, District Judge.

Plaintiff's amended complaint states a claim for patent infringement of Patent No. 2,742,327. Plaintiff, at pre-trial (order dated 4/9/63), narrowed the claimed infringement to claims 2, 6, 13, 16 and 17. The answer pre-dates the amended complaint and is deemed the answer to the amended complaint (pre-trial order). Defendant attacks the validity of the patent on the following grounds:

1. The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application in the United States (par. 6). See 35 U.S.C. §102(b).

2. The invention was known or used by others in this country or described in a printed publication before invention by plaintiff (par. 7). See 35 U.S.C. §102(a).

3. The subject matter is contained in patents granted to others filed in the United States before the invention

thereof by plaintiff (par. 8). See 35 U.S.C. §102(e), 35 U.S.C. §103.

4. The patent does not describe an "operable invention" (par. 8); and the claims are "vague, indefinite, and uncertain" (par. 9), and "the claims are broader than the invention" (par. 11).

Application for letters patent for a Fully Automatic Machine for making brushes was filed April 20, 1951, by Theodore Marks (Serial No. 222,007) Exhibit 1A. Letters Patent No. 2,742,327 was issued April 17, 1956. On April 25, 1951, one Hertzberg filed an application for letters patent for an invention under the title "Machine For Making Brushes". In August 1953, the Examiner suggested the language which eventually was numbered claims 16 and 17, for the purpose of interference. Letters patent were issued to Theodore Marks on April 17, 1956, and assigned by mesne assignments to plaintiff. The following patents were cited:

Weber	286,511	1883
Thacher	1,845,209	1932
Boardman	1,851,537	1932
Lipps	1,888,352	1932
Epp	1,941,343	1933
Scully	2,105,334	1938

PLAINTIFF'S CLAIM TO PATENT PROTECTION

Plaintiff claimed invention of an automatic wire brush manufacturing machine. Briefly described, the machine is designed to produce wire-twisted brushes of varying lengths not exceeding approximately 36". An upper and lower wire are continuously fed into the machine from two spools; the upper and lower wires engage pre-cut fibers or bristles fed from a hopper; the two wires holding the fibers or bristles in a more or less firm position, are then drawn into a pre-determined length; the wires holding the

bristles are then twisted by a rotating chuck; the twisted-wire brush is then cut. The brush is then complete and ready for packaging, except that in some varieties handles are added.

Plaintiff rests on claims 2, 16 and 17 as typical of the asserted claims. To understand the claims, examination of their component parts is helpful.

Claim 2[1] describes a fully-automatic machine for forming a brush by having spaced sets of fibers held between twisted wires. The mechanism contains the following elements: (1) a continuous under wire free at one end, (2) a continuous upper wire free at one end, (3) a fiber feeding device, or hopper, that places the pre-cut fibers between the upper and lower wire, (4) a method of pulling the fibers, evenly distributed, and firmly held to a pre-determined length, (5) a twisting operation to lock the fibers between the twisted wires, and (6) a cutting device.

Claim 16[2] describes the machine providing a means to keep the upper and lower wires parallel and adjacent to

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1. In a fully automatic machine for forming a brush having spaced sets of fibers held between a pair of twisted wires, means for supporting a continuous under wire free at one end, means for supporting a continuous upper wire free at one end, means for feeding onto the under wire and between it and the upper wire fibers spaced from each other, means for drawing the under wire and the upper wire with the spaced fibers therebetween to a selected length, means for twisting the wires to lock the fibers therebetween, and means for cutting the twisted wires to form the brush whereby the twisted wires are open at each end of the brush.

2. In a fully automatic machine for forming a brush, means for supporting an upper and a lower wire with leading portions substantially parallel and adjacent to each other, each wire being continuous with its leading portion having an exposed end, means for drawing the wires through the machine with said ends in the lead, means for feeding bristles onto the lower wire between it and the upper wire, means for twisting the wires to lock the bristles therebetween, and means for cutting the twisted wires to form the brush.

each other. The elements found in claim 2 for drawing the wires, feeding the bristles (or fibers) onto the lower wire and between the upper and lower wires, and the mechanism for twisting and cutting are repeated here.

Claim 17[3] restates the means found in claim 16 for supporting the upper and lower wires substantially parallel and adjacent to each other and the feeding of bristles (or fibers) onto the lower wire and between the lower and upper wires. It also describes the mechanism (1) for gripping the ends of the wires by a reciprocatable and rotatable chuck; (2) for pulling the wires to a predetermined distance; (3) remote from the exposed ends; (4) rotating the chuck to twist the wires and lock the bristles or fibers.

Plaintiff concedes that all the elements of the claimed invention were part in the public domain except the method of feeding pre-cut bristles between a pair of *moving* wires (Trans. p. 640-642); but contends the combination of such known elements performs a new and useful purpose, and rises to the standard of inventiveness required by 35 U.S.C. §101.[4] Defendant argues the claimed invention is anticipated by the prior art; if not

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3. In a fully automatic machine for forming a brush, means for supporting an upper and a lower wire with leading portions substantially parallel and adjacent to each other, each wire being continuous with its leading portions having an exposed end, a reciprocatable and rotatable chuck for gripping said ends of the wires, means for moving the chuck to pull the wires gripped thereby a predetermined distance, means for feeding bristles onto the lower wire between it and the upper wire as said wires are being pulled by the chuck, means for gripping the wires remote from the exposed ends, and means for rotating the chuck to twist the wires and lock the bristles therebetween.

4. 35 U.S.C. §101 states: Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

fully anticipated, the advance over the prior art "* * * would be obvious at the time the invention was made to a person having ordinary skill in the art * * *." 35 U.S.C. §103.

PRIOR ART

The twisting mechanism as described by plaintiff's patent was well known in the brush-making machine art. It was disclosed in the hand-twisting device of the Boardman patent 1,851,537 (1932), and in the Baumgartner patent 2,234,641 (1938), which disclosed a twisting operation by mechanical rotation of a chuck and providing longitudinal movement for the chuck to compensate for the reduced length of the twisted wires.

The twisting mechanism of plaintiff's patent is fully disclosed in A. L. LeFebvre, et al. 2,542,686 (1947) (Ex. J—13).

One of the problems in the art prior to the advent of semi-automatic machines (1942) was the retaining of the bristles in position for twisting before the twisting operation commenced. H. Cave, et al. 2,358,443, (1942), claimed invention of a brush-making machine whereby a pre-cut wire is first placed on a carrier, the carrier moves to a position to receive a measured lot of bristles from a magazine; the carrier then moves to another position to receive another wire; the carrier then positions the bristles so held by two wires, between two chucks. The twisting mechanism operation then follows the conventional procedure of twisting the wires by rotating chucks that grasp them at both ends. Earlier, Lipps 1,888,352 (1932) (Ex. J—16) claimed invention for a method of supplying fibers from a hopper on to an assembly rack. The bristles were held in place by manually clamping and then

applying core wires; this assembly was then manually transferred to the twisting mechanism.

A. L. LeFebvre 2,572,498 (1946) (Ex. J—12) disclosed a brush-making machine similar to H. Cave, et al.

The semi-automatic brush-making machines disclosed a mechanism for spreading fibers on a wire and the placing of a wire topside, so that the fibers were between two wires. In this position, the fibers held between the wires were transported to the twisting device that provided the mechanism for the final operation prior to insertion into a handle.

At the time of the filing of the Marks application, the brush-making machine art did not disclose a machine capable of making wire brushes from spools or rolls of wires, that would trap and twist fibers or bristles. Spools or reels of wire continuously fed in a machine is disclosed in a Finnish patent granted to Paavo Emil Valisalo 23,347 published July 7, 1949 and in the U. S. Patent Office September 19, 1949 (Ex. J-23). The patent describes the device as a machine for "making pipe cleaners, lamp brushes, steel brushes, Xmas decorations, etc., where cotton, nylon, or metal are used and which are fastened with 2 or more interwining metallic core-wires." The method described by the claim is the winding of a thread about one core wire, simultaneously twisting the core-wires together. The thread is cut after the twisting operation has secured it. The patents granted to H. P. Ruf 1,801,388 (1930) (Ex.—20) for a machine making a twisted cord known as ruff cord and chenille and to Henri-Guido Le Moine 876,067 (French) applications filed June 11, 1941, published in the U. S. Patent Office October 13, 1942, for a machine making twisted fringes or coils of metal threads containing threads as fibers, also teach continuous feeding of wire into a machine.

ANTICIPATION BY THE PRIOR ART

The use of a hopper or magazine for holding pre-cut fibers and the feeding mechanism was disclosed. The gripping device as disclosed by Marks was obvious to one skilled in the art. The vital question is, whether the means for feeding pre-cut fibers, more or less evenly spaced between an upper and lower wire substantially parallel and adjacent with each other, was either anticipated or obvious to one skilled in the art. The feeding of continuous wires from rolls was disclosed by machines designed for making chenille, pipe cleaners, etc., previously referred to. Such machines did not, however, disclose means for supporting upper and lower wires substantially parallel and adjacent to each other. The materials used in such machines were cut after twisting. The problem in brush making—of holding bristles between wires prior to twisting—was not present producing chenille or similar items.

The means described by Marks shows the wires pulled by a chuck over tension roller wheels. The upper wire passes immediately over the bristles position on the under wire to grip them between the two wires which are in tension (Marks Ex. 3—Col. 4—l. 65-68). A wire-holding fork, in an intermediate position permits the wires, holding the bristles, to pass through to a pre-determined length. The holding fork is lowered to its ultimate positions. Two jaws of a vise then move horizontally to firmly hold the wires. The twisting and then the cutting of the twisted wire ensues and completes the machine operation.

OBVIOUSNESS AND ANTICIPATION BY THE PRIOR ART

There is little doubt the Marks machine was an advance over the prior art. It produced brushes at a faster rate than any previous brush-making machine; it did not require the degree of skill in its operation that machines, then known, demanded. *Webster Loom Co.* v. *Higgins,* 1882, 105 U. S. 580, 581, 26 L. Ed. 1177. It substantially reduced the cost of making twisted-wire brushes. The brush-making field was narrow. The relatively few manufacturers who required a machine of the productive capacity of the Marks device recognized its usefulness. Within this narrow field, the machine was commercially successful. The need was heightened by the widespread use of twisted brushes in hair curlers, and the consequent demand for a low-priced brush.

The means, disclosed in the specifications, for supporting the upper and lower wires substantially parallel and adjacent to each other appear novel and nowhere disclosed by the prior art. Claims 6, 13, 16 and 17 read too broadly in this regard and they will be read in the light of the disclosure. *Schick Dry Shaver, Inc.* v. *R. H. Macy & Co.,* 1940, 2 Cir., 111 F. 2d 1018, 1022; *Cuno Engineering Corp.* v. *Meehl,* 1940, 2 Cir., 113 F. 2d 862, 863. The means disclosed is not found in the teaching of any of the prior art patents nor were the means obvious to one skilled in the art of brush-machine making. To this extent, the Court finds novelty in claims 6, 13, 16 and 17.

The feeder mechanism and the twisting mechanism were known to the prior art. The refinements and variations in the individual operations, as disclosed by the claims under consideration, are of no consequence and are not entitled

to patent protection. Synchronizing these individual and separate operations into one continuous method of production is in a different category.

In determining the patentability of a combination of known elements, the test is whether such combination is in itself novel. Such combination must rise to the level of invention. If the net effect is to diminish that store of prior art which is public property—in the public domain—then patent protection must be denied. The Supreme Court in Great Atl. & Pac. Tea Co. *v.* Supermarket Equip. Corp., 1950, 340 U. S. 147, 151, 71 S. Ct. 127, 130, 95 L. Ed. 162, quoted with approval Lincoln Engineering Co. *v.* Stewart-Warner Corp., 303 U. S. 545, 549, 58 S. Ct. 662, 664, 82 L. Ed. 1008.

> "The mere aggregation of a number of old parts on elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention."

The semi-automatic brush machines did not anticipate the combination referred to. In those machines, a complex mechanism was employed to transport the brush assembly and place it in position for twisting. Marks moves the brush materials along as part of the manufacturing process.

A new element in combination with old elements which performs a new, different and useful function not disclosed by the prior art, is novel. It is novel only in the combination in which it exists and functions. The inventor created an integer. The novel combination is protected in the form presented by the inventor. It is thus narrowly construed. Piggly-Wiggly Corporation *v.* Jitney Jungle

Corporation, 1930, 5 Cir., 39 F. 2d 592, cert. denied 282 U. S. 858, 51 S. Ct. 33, 75 L. Ed. 760. The range of equivalency is similarly limited and excludes everything not substantially identical with the elements disclosed by the inventor. Walker on Patents (Deller's Edition), Vol. Three, p. 1719 et seq. §475 (cases cited and discussed). Particularly is this true where the broad claims were narrowed by the allowance of claims after rejection of original claims and an interference. Walker on Patents (Deller's Edition) Vol. Two, p. 1215 et seq. §249.

ACCUSED DEVICE

The accused device is based on a patent issued to A. Briglia 3,112, 957 (April 1960). The Marks patent was cited by the Examiner.

Defendant claims the issuance of the patent to Briglia subsequent to the issuance of the Marks patent raises a presumption of non-infringement, citing Boyd *v.* Jaynesville Hay-Tool Co., 1895, 158 U. S. 260, 15 S. Ct. 837, 39 L. Ed. 973. The Court noted that "• • • both applications were pending in the patent office at the same time"; since an interference proceeding was not initiated, the Court reasoned that it was the judgment of the patent office "• • • that there were features which distinguished one invention from the other." (158 U. S. at p. 261, 15 S. Ct. at p. 837) The Court then quoted with the approval from American Nicholson Pavement Co. *v.* City of Elizabeth, 4 Fish. Pat. Cas. 189, Fed. Cas. No. 312 where the Court stated:

> "It raises the presumption that, according to the claims of the later patentees, this invention is not an infringement of the earlier patent." (158 U. S. at p. 261-262, 15 S.Ct. 837).

Cf. Matthews *v.* Koolvent Metal Awning Co., 1947, 5th Cir., 158 F.2d 37; Sid W. Richardson, Inc. *v.* Bryan, 1958, S.D. Tex., 144 F. Supp. 916, aff'd 254 F. 2d 191.

The plaintiff has the burden of establishing infringement. The issue of infringement turns on whether the accused machine invades the area of monopoly granted plaintiff. The validity of the Briglia patent is not in issue. The claims and disclosures in the Briglia patent are pertinent to the issue of infringement. Where the issue of infringement is contested the "presumption of non-infringement" has no effect. To give it weight would alter the burden of plaintiff's proof to one greater than a fair preponderance of the credible testimony. The Court rejects such concept.

The Court nevertheless determines the issue of infringement against plaintiff. The means disclosed by Marks for holding upper and lower wires substantially parallel and adjacent are absent in Briglia. In Briglia, the wires are fed over pulleys from friction-retarded spools and pass through wire-gripping jaws with bristles, there trapped, prior to twisting. The omission of this element from the Briglia machine, without introducing an equivalent avoids infringement of claims 6, 13, 16 and 17. In Miller *v.* Life Savers, Inc., 1933, 2 Cir., 62 F.2d 513, 516, the Court said:

> "We hold that defendant does not infringe because it does not employ the curling process described in the Miller patent. * * * The defendant's machine has no 'means for curling' a plastic rod of constant diameter about a post such as Miller shows * * *."

The difference in the pulling and twisting operation in Briglia also avoids the protected area of the Marks

claims. In the former device, it is a simultaneous operation; in the latter, it is not. Because of this difference, the Briglia machine can produce a longer brush than the Marks machine, but the bristles are not as evenly, fully and tightly held as in the product produced by the Marks machine. Briglia was at liberty to use the prior art in a combination and did not encroach on the Marks patent.

Plaintiff urges that the differences between the patented device and the accused machine are no more than the transportation of parts and the use of equivalents. Hookless Fastener Co. *v.* G. E. Prentice Mfg. Co., 1935, 2 Cir., 75 F.2d 264, 267, *cert. den.* 295 U. S. 748, 55 S. Ct. 826, 79 L. Ed. 1693. The wires do not hold the bristles in the Briglia machine in the same manner as in Marks. The lot of bristles in Marks is held firmly between the two wires until the twisting operation begins. In Briglia, the wires hold small portions of each lot until it is trapped by the twisting operation. The use of chuck and gripping device in the Marks machine is different from the Briglia machine. The product is similar but the difference in the product are obvious.

Whether the differences are designed with a view to avoiding infringement of the Marks patent is of no significance. Reiner *v.* I. Leon Co., 1963, 2 Cir., 324 F.2d 648, 651. The Court finds the Briglia patent did not infringe the Marks claims.

Findings of fact and conclusions of law in accordance with this memorandum of decision signed and filed this day.

Findings of Fact and Conclusions of Law

UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF NEW YORK

AMERICAN TECHNICAL MACHINERY CORP., (Substituted for American Brush Machinery Company, Inc.),

Plaintiff,

v.

SYLVESTER CAPAROTTA, doing business as Kings Brush Co. and as Kings Brush & Mop Co.,

Defendant.

FINDINGS OF FACT

A. *Jurisdiction*

1. Defendant, Sylvester Caparotta, has a regular place of business at 17 Williams Avenue, Brooklyn, New York, which is in the territorial jurisdiction of this district court and does business at said premises under the firm and style name of Kings Brush Company and Kings Brush and Mop Company.

2. The claimed acts of infringement occurred at defendant's place of business, i.e., 17 Williams Avenue, Brooklyn, New York.

3. Jurisdiction is conferred by 28 U.S.C. §1338 and 28 U.S.C. §1400.

B. *Validity*

4. Plaintiff, American Technical Machine Corp., a corporation organized under the laws of the State of New York with its principal place of business at 29 Elm Ave-

nue, Mount Vernon, New York, is owner, by assignment, of a patent issued to Theodore Marks. (App. filed April 20, 1951) No. 2,742,327.

5. The prior art consisted of

(a) hand twisters:

Baumgardner	2,234,641	(1941)
Boardman	1,851,537	(1932)
Hertzberg	1,824,140	(1931)
LeFebvre	2,542,686	(1947)
Openshaw	2,442,661	(1948)

(b) Semi-automatic brush making machines:

Cave, et al.	2,358,443	(1942)
LeFebvre	2,572,498	(1946)
LeFebvre	2,542,687	(1947)
Lipps	1,888,352	(1932)

(c) chenille making machines:

LeMoine	876,067	(French)
Ruf	1,801,388	
Valisalo	23,347	(Finnish)

(d) Core brush making machines:

Angell	1,721,062	(1929)
Cave	1,871,775	(1925)
Enchelmaier	2,701,739	(1950)
Griscom	2,035,881	(1936)
Scully	2,105,334	(1938)
Thacher	1,845,209	(1932)

6. The Marks patent cited:

Weber	286,511	(1883)
Thacher	1,845,209	(1932)
Boardman	1,851,537	(1932)
Lipps	1,888,352	(1932)
Epp	1,941,343	(1933)
Scully	2,105,334	(1938)

7. Plaintiff's claim is based upon claims 2, 6, 13, 16 and 17 of the aforementioned patent (see pre-trial order dated April 9, 1963).

8. Claims 6, 13, 16 and 17 state "means for supporting an upper and lower wire in substantially parallel adjacent relation."

9. The specifications disclose the means to be a holding fork lowered to its ultimate position as two jaws of a vise, moving horizontally, hold the wires laterally.

10. The claim[s] set forth in finding 8 as limited by finding 9 is a new and useful improvement.

11. The prior art disclosed devices for holding bristles between pre-cut wires and the twisting mechanism incorporated in plaintiff's patent.

12. The synchronization of the devices herein referred to in finding 11 and the incorporation of such separate operations into a continuous operation (however not simultaneous—see finding 23) was not obvious to one skilled in the art and not anticipated by the prior art.

13. The new and useful device set forth and described in findings 8, 9 and 10 in combination with devices in the prior art described in 11 and 12 is new and useful.

14. The Marks machine attained commercial success.

15. The Marks machine twisted wire brushes at a faster rate than previously known machines, eliminated the need for skilled labor in the twisted wire-brush making business, and reduced the cost of twisted-wire brushes with large-volume brush manufacturers.

16. The Marks machine was a major factor in reducing the cost of hair-curler brushes. The price to the hair-

curler manufacturer was reduced from approximately $26.00 per thousand to approximately $5.00 per thousand.

17. The bristle-feeding mechanism was disclosed by Lipps, 1,888,352 (1932) and H. Cave, et al., 2,358,443 (1942) and others.

18. The continuous feeding of wire into the machine is disclosed by Valisalo, 23,347 (Finnish) and Le Moine, 876,067 (French) and others.

19. The rotatable chuck is disclosed by Angell, 1,721,026.

20. The movement of the chuck, the manner of gripping the exposed ends of the wires and the cutting mechanism described in the patent were methods of using known devices obvious to one skilled in the machine-making art. R. O. Peterson, et al., 2,580,378.

C. *Infringement*

21. The accused device known as the "Briglia Machine" (based on a patent issued to A. Briglia 3,112,957—app. April 1960) provides for tautening of the wires by the use of friction retarded spools that trap bristles from a feeding magazine or hopper.

22. The means used by Briglia is not disclosed by Marks.

23. The twisting and pulling operation performed simultaneously by Briglia is not disclosed by Marks, nor is such device an equivalent to the Marks device.

24. The Briglia machine omits the element found in the Marks machine and described as "means for supporting an upper and lower wire in substantially parallel adjacent relation."

Conclusions

1. Claims 2, 6, 13, 16 and 17 of patent No. 2,742,327 are valid claims.

2. The Court has considered the validity of claims 2, 6, 13, 16 and 17 only.

3. Defendant's machine does not infringe on claims 2, 6, 13, 16 and 17.

4. A judgment shall be settled on two (2) days notice sustaining the validity of the aforementioned claims and in favor of the defendant on the claim stated in the complaint and in favor of the plaintiff, dismissing counterclaim stated in the answer.

Brooklyn, New York, March 31, 1964.

Jacob Mishler
U. S. D. J.